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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/070,196	03/04/2002	Jian-Zhong Yang	AA420F	9246

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EXAMINER

LAMM, MARINA

ART UNIT

PAPER NUMBER

1616

DATE MAILED: 07/21/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/070,196

Applicant(s)

YANG ET AL.

Examiner

Marina Lamm

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 19 May 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

Acknowledgment is made of the amendment filed 5/19/03. Claims pending are 1-8.

Claims 1, 2, 7 and 8 have been amended.

#### *Claim Rejections - 35 USC § 103*

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Uchiyama et al.

Uchiyama et al. teach hair conditioning compositions having a layered gel structure containing liquid high molecular weight ester oils, hydrophobically substituted cationic surfactant and high melting point fatty compounds in an aqueous carrier. See Abstract; p. 11, line 27. The cationic surfactants are present at a level of 0.1 to 20%. See p. 33, lines 1-5. The high melting point fatty compounds are present at a level of 1 to 14% and include solid fatty alcohols and fatty acids such as cetyl alcohol, stearyl alcohol, behenyl alcohol, lauric, palmitic, stearic, behenic, sebacic acid and their mixtures. See p. 9, lines 16-31. Uchiyama et al. also teach alkyl ethoxylates of the instant invention, e.g. ceteth, steareth, cetareth compounds and oleth-2 as both high melting point fatty compounds and additional oily ingredients. See p. 10, lines 1-10; p. 25, line 8. The compositions of Uchiyama et al. may contain additional oily compounds such as fatty alcohols, acids, esters and hydrocarbons. See pp. 24-26. The reference is silent with respect to the reduction of bulk volume by at least 10% as claimed in Claim 2. However, one of the problems addressed by Uchiyama's invention is "increased level of static" or "fly-away hair". See p. 1, lines 21-27. With respect to Claims 4 and 7, Uchiyama

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et al. do not explicitly teach the claimed concentration of alkyl ethoxylate. However, Uchiyama et al. list ceteth, steareth, cetareth compounds among high melting point compounds which are employed at a level of 1-14%. See pp. 9-10. Therefore, it would be conventional and within the skill of the art to identify the optimal concentration of alkyl ethoxylate in order to achieve the desired hair conditioning effect. With respect to Claim 7, Uchiyama et al. is silent about the gel matrix viscosity. However, the gel matrices of Uchiyama et al. appear to have the viscosity within the claimed range because the concentration of gel matrix components of Uchiyama et al. overlaps with the claimed ranges. Since the Office does not have the facilities for examining and comparing applicants' product with the product of the prior art, the burden is on applicant to show novel and unobvious differences between the claimed product and the product of the prior art (i.e., that the gel matrix of the prior art does not have the claimed viscosity). With respect to Claim 8, Uchiyama et al. teach making their compositions by mixing high melting point compounds and cationic surfactant and heating the mixture up to above 70°C and then adding the remaining components at lower temperatures (below 50°C). See p. 30, lines 8-17. The reference does not explicitly teach combining the formed gel structure with alkyl ethoxylate at a temperature below 60°C. However, the temperature recited in the reference and that recited in the instant claim are close enough that, absent showing to the contrary, one skilled in the art would have expected the resulting compositions to have the same properties. With respect to the limitation "wherein the alkyl ethoxylate is combined with the gel matrix at a temperature of less than 60°C" in Claims 1 and 7, the courts have held that a claim to a composition defined by reference to the process by which it is produced, is not limited to compositions produced by

the process recited in the claim. Scripps Clinic & Research Foundation v. Genentech, Inc. (CAFC 1991) 927 F2d 1565, 18 PQ2d 1001. Therefore, process limitations cannot impart patentability to a product which is not patentably distinguished over the prior art. In re Thorpe et al. (CAFC 1985) 771 F2d 695, 227 USPQ 964. Although the cited reference does not teach the process step disclosed in the instant claims, one having ordinary skill in the art at the time of the invention would have a reasonable expectation of arriving to the applicant's hair care composition using the processes described in the reference. Where a product by process claim is rejected over a prior art product that appears to be identical, although produced by a different process, the burden is upon the applicants to come forward with evidence establishing an unobvious difference between the two. In re Marosi, 218 USPQ 289 (Fed. Cir. 1983).

Therefore, the invention as a whole would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made.

### ***Response to Arguments***

3. Applicant's arguments filed 5/19/03 have been fully considered but they are not persuasive.

In response to the Applicant's argument that the reference discloses a variety of high melting point fatty compounds including those of the instant claims but gives no motivation to select certain alkyl ethoxylates (see p. 7 of the response), it is noted that the selection of optimal species of alkyl ethoxylates within the reference's generic disclosure in order to obtain the desired hair conditioning effect is within the skill of ordinary practitioner. If routine experimentation by one of ordinary skill would have led to the use of the particular chemical recited in the claimed composition, the composition is obvious, even though the results

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obtained by the composition are unexpectedly high. In re Miegel et al. (CCPA 1968) 404 F2d 378, 159 USPQ 716. Same to arrive at an optimum combination. Indiana General Corp. v. Krystinel Corp. (CA 2 1970) 421 F2d 1023, 164 USPQ 321. Further, the Applicant argues that the amended claims now recite that alkyl ethoxylate is added after the formation of gel matrix at a temperature below 60°C. See p. 7 of the response. In response, it is noted that a claim to a composition defined by reference to the process by which it is produced, is not limited to compositions produced by the process recited in the claim as discussed above. Further, the Applicant argues that oleth-2 of Uchiyama et al. has an HLB of 5 and, therefore, is outside of the scope of the instant claims. See p. 8 of the response. In response, it is noted that oleth-2 is not the only alkyl ethoxylate taught by the reference. The reference also teaches ceteth 1 through 45, steareth 1 through 10 and cetareth 1 through 10, which include alkyl ethoxylates having HLB within the claimed range of 6-11. See p. 10 of the reference. Since the Uchiyama's hair conditioning compositions are intended to alleviating the problem of "fly-away hair", it is the Examiner's opinion that the selection of optimal species of alkyl ethoxylates within the reference's generic disclosure in order to obtain the desired hair conditioning effect is obvious and within the skill of ordinary practitioner. One having ordinary skill in the art would have been motivated to do this to obtain the hair conditioning composition which alleviates the after-shampoo problem of "fly-away hair" and provides long lasting moisturizing and smooth feel as well as manageability control to the hair as suggested by Uchiyama et al. on pp. 1-2.

*Conclusion*

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marina Lamm whose telephone number is (703) 306-4541. The examiner can normally be reached on Monday to Friday from 9 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page, can be reached at (703) 308-2927.

The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

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MICHAEL G. HARTLEY  
PRIMARY EXAMINER